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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,773	12/20/2001	Noriaki Ogishima	217573US2	6918

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

EXAMINER

HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,773

Applicant(s)

OGISHIMA, NORIAKI

Examiner

Calvin L Hewitt II

Art Unit

3621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-32 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites printing enciphered data. However, in the previous step the data has been deciphered (i.e. the enciphered data is now deciphered).

Therefore, the scope of the claim cannot be determined as it is not clear, to one of ordinary skill, how the apparatus is to function.

Claims 2-10 are also rejected as they depend from claim 1.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6-9, 11-16, 18-23, and 25-32 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ruberry et al, U.S. Patent No. 6,356,287.

As per claims 1-4, 6-9, 11-16, 18-23, and 25-32, Ruberry et al. teach an image forming apparatus (figure 1) comprising:

- deciphering means for receiving and deciphering enciphered data (column 5, lines 10-15)
- printing means for printing (i.e. writing) enciphered data on a recording medium (column 5, lines 50-54)
- request generating means for requesting the enciphered data with respect to an external server (figure 4; column 4, lines 27-50; column 5, lines 15-23)

- key generating (to define or originate, as a mathematical structure, by the application of one or more rules or operations- Webster's Ninth New Collegiate Dictionary) means for generating an enciphering key (the process with which the remote server retrieves or accesses the key stored on the device) for use in an enciphering process (column 5, lines 15-17) wherein said key is unique to the image forming apparatus (column 5, lines 15-23)
- a transmitting step enciphering requested data in a server and transmitting enciphered data via a network (column 5, lines 13-18)
- requesting enciphered data from a terminal coupled to an apparatus or apparatus (figures 1 and 4), deciphering the data in an apparatus that has a printing function and printing (i.e. writing) deciphered data onto a recording medium (column 5, lines 54-58)
- updating software based on the deciphered data (figures 6, 7, 9, 10, 12-14, 17 and 18)
- request means in an apparatus or in a terminal coupled to the apparatus (figures 1 and 4)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 10, 17, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruberry et al., U.S. Patent No. 6,356,287 in view of Chou et al., U.S. Patent No. 5,337,357.

As per claims 5, 10, 17, and 24, Ruberry et al. teach an image forming apparatus for accessing and storing encrypted data and decrypted said data for presentation to a user (abstract; figures 1 and 4; column 5, lines 15-23). Ruberry et al. also teach encrypting said data using a key unique to said apparatus (column 5, lines 15-23). However, Ruberry et al. do not specifically recite generating an encrypting key using a random variable. Chou et al. teach a method for generating an encryption key that is unique to the content receiving apparatus using a random variable (abstract). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Ruberry et al. and Chou et al. in order to make the key unique for each transaction through the introduction of a random variable thus preventing an intruder from using an intercepted or stolen key.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Holmes et al. teach a secure electronic publishing system
- Stefik et al. teach a system for secure printing of digital works
- Colosso teaches a method for licensing content

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

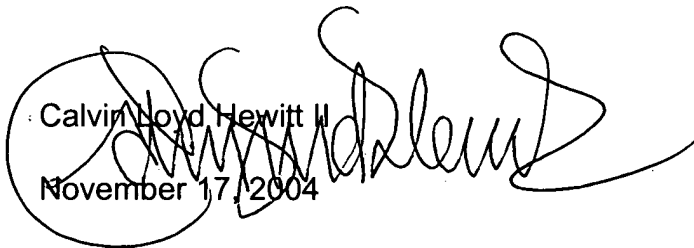
(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.


Calvin Lloyd Hewitt II
November 17, 2004